

### REMARKS

The comments of the applicant below are each preceded by related comments of the examiner (in small, bold type).

**2. Claims 15-28,36 and 37 are rejected under the judicially created doctrine of obviousness- type double patenting as being unpatentable over claims 1-14 of U.S. Patent No. 6,725,973. Although the conflicting claims are act identical, they are not patentably distinct from each other because they are obvious variations of breadth and scope.**

The applicant disagrees with the examiner's position. Without making any concession, the applicant will submit a terminal disclaimer to remove the rejection.

**4. Claims 15-23 are rejected under 35 U.S.C. 102(b) as being anticipated by Heller (USPN 3,565,213).**

**Heller discloses a lubricator to apply lubricant to a strand (20) as it is pulled through a conduit, the lubricator including a coupling feature (14) to mate with a corresponding coupling feature (corresponding threads,) of a bushing; the strand comprises an insulated electrical wire or the like; the coupling feature of the lubricator comprises threads; the threads comprise external threads; the lubricator also includes a second coupling (15) feature configured to mate with a corresponding coupling feature of the conduit; the second coupling feature of the lubricator comprises threads; the threads comprise internal threads; a body of the lubricator is formed of two connectable components (16. II); a lubricator to apply lubricant to a strand as it is pulled through a conduit, the lubricator including an external thread to mate with a corresponding internal thread (14) of a bushing and an internal thread (15) to mate with a corresponding external thread (13) of the conduit.**

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**The applicant argues that claim 15 is patentable because Heller reference does not disclose "a bushing." Sections 10 and 11 are bushings. According to the Merriam-Webster OnLine dictionary a bushing is "a usually removable cylindrical lining for an opening (as of a mechanical part) used to limit the size of the opening, resist abrasion, or serve as a guide." Section 10 and 11 are "removable cylindrical linings[s] for an opening [] [opening of 16] used to limit the size of the opening [] and serve as a guide[s]." Thus sections 10 and 11 are bushings and Heller anticipates this limitation.**

Claim 15 has been amended. With regard to the examiner's interpretation of Heller, the applicant disagrees. Heller clearly states at column 2, lines 30-33, that "pipe sections 10, 11 of

the conduit are threaded at the respective end portions **12, 13** thereof to engage the respective screw threads **14, 15** of the water-proof sleeve coupling **16**.” The examiner cannot have it both ways as to what is the conduit and what is the bushing in Heller. The conduit must either be the pipe sections **10** and **11**, as is clearly the case, or must be the sleeve coupling **16**. If the pipe sections are the conduit, and the sleeve coupling the lubricator, there is no bushing. If the sleeve coupling is the conduit, and the pipe sections are the bushing, then the lubricator must be element **22** (Heller does not explicitly identify element **22**, but it refers to a fitting in that location as the source of the lubrication). Under this interpretation, the lubricator does not mate with the bushing. If the pipe sections are the conduit, and the sleeve coupling is the bushing, then element **22** must again be the lubricator, in which case the strand is not “pulled through the lubricator and a conduit.” Thus Heller does not describe and would not have made obvious both of “a lubricator to apply lubricant to a strand as it is pulled through the lubricator and a conduit” and that same “lubricator including a coupling feature to mate with a corresponding coupling feature of a bushing.”

**The applicant argues that claim 23 is patentable because Heller does not disclose an external thread. Heller discloses both internal and external threads. External threads are disposed on pipe sections 10 and 11 and internal threads are disposed on coupling 16. Coupling 16 is also a bushing because it is removable and it serves as a guide for the strand. Heller, therefore, also anticipates claim 23.**

The external threads in Heller are part of the pipe sections **10** and **11**, not part of the lubricator contained within or comprising the sleeve coupling **16**. Further, even if the sleeve coupling **16** could reasonably be considered a bushing, it cannot be both the lubricator of claim **23** and the bushing to which the lubricator may be mated. If the sleeve coupling **16** is the bushing, then the lubricator must be the fitting **22**. That fitting clearly has only external threads and connects only to the sleeve coupling **16**, not to the pipe sections **10** and **11**. Heller does not describe and would not have made obvious a single lubricator including *both* internal and external threads for mating to both a bushing and conduit.

**5. Claims 24, 25 and 28 are rejected under 35 U.S.C. 102(b) as being anticipated by Charlton (USPN 4,296,837)**

**Charlton discloses a lubricator to apply lubricant to a strand as it is pulled through a conduit, the lubricator comprising two body sections (18, 16) that can be**

connected to one another to form the lubricator, each of the body sections comprising a sleeve (20), the sleeves of the two body sections being aligned when the two body sections are connected to form the body, and a pin (hinge pin through 20) that slides into the sleeves to hold the body sections together;  
the lubricator include, an axis that is aligned along the length of the strand and the pin includes an axis that is parallel to the lubricator axis;  
electrical wire.

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The applicant argues that claim 24 is patentable over the Charlton reference because the hinge pin of Charlton permanently connects the two half sections 16 and 18. The hinge pin of Charlton is removable. Anticipation of a removable pin is not precluded by the fact that it might require a tool or tools to remove the pin of hinge 20. Thus Charlton anticipates this limitation.

Without making any concession, claims 24-28 have been cancelled.

7. Claims 26,27 and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Charlton in view of Mefferd (USPN 5,269,572).

Charlton discloses all of the instantly claimed invention except a second pin and respective sleeves.

Mefferd discloses a second pin (104).

To modify the apparatus of Charlton so as to provide a second pin would have been obvious to one of ordinary skill in the art at the time the invention was made in view of the teachings of Mefferd that such an arrangement improves the ability of the device to be quickly connected and disconnected.

With regard to claim 36, Neither Charlton nor Mefferd describe or would have made obvious features including at least (a), "an interior reservoir formed by [the] body sections when assembled together" or (d), "threads formed by [the] assembled body sections."

8. Claim 37 is rejected under 35 U.S.C. 103(a) as being unpatentable over Charlton in view of Mefferd and Oetiker (USPN 4,693,502).

The Charlton and Mefferd combination (see above) show all of the instantly claimed invention except a seal.

Oetiker shows a seal(15).

To modify the reference combination above so as to provide a seal would have been obvious to one of ordinary skill in the art at the time the invention was made in view of the teachings of Oetiker that such an arrangement improves the ability to contain flow, making the process more efficient.

Claim 37 is patentable for at least the same reasons as claim 36 with respect to element (a). The examiner has not provided reasons for rejection of claim 38. Claim 38 is patentable for at least the reasons for which claim 36 is patentable.

All of the dependent claims are patentable for at least the reasons for which the claims on which they depend are patentable.

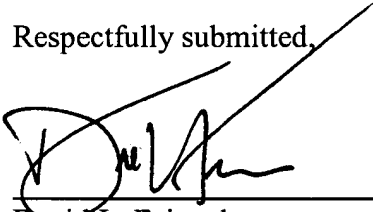
Canceled claims, if any, have been canceled without prejudice or disclaimer.

Any circumstance in which the applicant has (a) addressed certain comments of the examiner does not mean that the applicant concedes other comments of the examiner, (b) made arguments for the patentability of some claims does not mean that there are not other good reasons for patentability of those claims and other claims, or (c) amended or canceled a claim does not mean that the applicant concedes any of the examiner's positions with respect to that claim or other claims.

Enclosed is a \$225 check for the Petition for Extension of Time fee. Please apply any other charges or credits to deposit account 06-1050, reference 16076-002002.

Respectfully submitted,

Date: 12/5/5

  
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